

elastic deformation of the plurality of flexible fingers as the respective portion of the at least one of the first seal member and second seal member is crimped into the respective at least one of the first annular interface and the second annular interface.

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46. (New) The method of claim 41, wherein at least one of the first seal member and the second seal member includes a flinger.

47. (New) The method of claim 41, wherein at least one of the first seal member and the second seal member supports an elastomeric seal, the at least one of the first seal member and the second seal member comprising part of an annular support ring.

REMARKS

In the Office Action, claims 1-21 were rejected and claims 38-40 were withdrawn from consideration. By the present Response, claims 1-7 are canceled without prejudice, and claim 38 is amended. Additionally, new claims 41-47 have been added. These new claims include one independent claim and six dependent claims. Because one independent claim and six dependent claims have been canceled without prejudice, the addition of an equivalent amount of new independent and dependent claims requires no additional fee. Upon entry of the amendments and addition of new claims, claims 8-21, and 38-47 will be pending in the present patent application. Reconsideration and allowance of all pending claims are requested.

Election / Restrictions

Applicant respectfully asserts that claims 38-40 should not be withdrawn from consideration as being directed to a non-elected invention because the inventions are not distinct. Claims 38-40 are product-by-process claims and are related as process of making and product made. The MPEP indicates that inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make

other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)).

Applicant respectfully asserts that neither of these can be shown. The process claimed will not make product materially different from the product of claims 38, 39 and 40. Therefore, the first prong of the above mentioned test does not indicate a distinction between the process of making and product made. Applicant further asserts that there is no known method ("another and materially different process") for crimping *multiple seals* as recited in the claims. Therefore, the second prong of the above mentioned test does not indicate a distinction between the process of making and the product made. Because claims 38, 39 and 40 are not distinct from and independent of the invention previously claimed, this restriction should be withdrawn and claims 38, 39 and 40 should be considered. See 37 C.F.R. 1.142(b) and MPEP § 821.03.

Rejections Under 35 U.S.C. § 112

The Examiner rejected claim 5 under 35 U.S.C. § 112. Claims 1-7 have been canceled without prejudice. Therefore, all claim rejections under 35 U.S.C. § 112 are moot.

Rejections Under 35 U.S.C. § 102

The Examiner rejected claims 1, 2, and 4-7 under 35 U.S.C. § 102(b). Claims 1-7 have been canceled without prejudice. Therefore, all claim rejections under 35 U.S.C. § 102(b) are moot.

Rejections Under 35 U.S.C. § 103

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the

combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

The Examiner rejected independent claims 8 and 15 as being unpatentable over McLarty (U.S. Pat. No. 5,242,229) under 35 U.S.C. § 103. The Examiner admits that McLarty "does not disclose crimping the first and second pieces of the bearing seal to the inner and outer races of the bearing, respectively." Page 6, Line 5-6. However, the Examiner asserts that claims 8 and 15 are made obvious to one having ordinary skill in the art by McLarty in light of the crimping process disclosed in the prior art disclosure of McLarty.

It should be noted that the Examiner's argument here is contradictory to the Examiner's later assertion that claims 8 and 15 are obvious over McLarty or Mondak et al (U.S. Pat. No. 5,695,290) in view of Reiter (U.S. Pat. No. 4,336,971). If McLarty was sufficient alone to allow a rejection under 35 U.S.C. § 103, it would not require additional references.

Applicant respectfully disagrees with Examiner's assertion of obviousness. A prior art reference must be considered in its entirety, i.e., as a whole, including portion that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). The McLarty reference actually *teaches away* from a crimping process. This teaching away is demonstrated in column 1, lines 32-59 of the McLarty reference, which illustrates "limitations known to exist." Column 1, line 53. Therefore, McLarty does not teach crimping a first seal member and a second seal member as recited in claims 8 and 15, but clearly teaches away and cannot be the basis of an obviousness rejection. Further, based on the disclosure in McLarty, it does not appear possible to crimp a first seal member *and* a second seal member because there is no apparent means of reaching *both* members for crimping. The Examiner appears to pick and choose among disclosures to deprecate claims 8 and 15. There is no reason one of ordinary skill in the art would have found claims 8 and 15 obvious in light of the teachings of the McLarty reference.

The Examiner also rejected claims 8 and 15 under 35 U.S.C. 103 as being unpatentable over McLarty or Mondak et al in view of Reiter. Once again, the Examiner admitted that these references do not disclose "crimping the first and second pieces of the bearing seal to the inner and outer races of the bearing, respectively." Office Action, page 7, lines 10-11. No combination of the provided references obviates the admitted failure to disclose. Further, here again, it does not appear possible to crimp a first seal member *and* a second seal member because there is no apparent means of reaching *both* members for crimping. Thus, the Examiner has not established a *prima facie* case for obviousness because there is no teaching or suggestion supporting the proposed combination. In fact, as discussed above, at least one reference clearly teaches away from the proposed combination. Therefore, claims 8 and 15 are not obvious over McLarty or Mondak et al in view of Reiter.

It is clear that all of the prior art references cited by Examiner in the 35 U.S.C. 103 objections merely teach "snap fit" seals or "snap fit" seals in combination with crimped seals. None of the references cited by Examiner discloses crimped multiple seals. One reason crimping is a better solution than using a snap fit is because crimping creates a more secure attachment that is less susceptible to wear. A mere snap fit will be more susceptible to movement within an associated groove. This movement, often referred to as "walking," is a result of drag forces placed on the moving elements of the bearing and can be detrimental to proper operation and can lead to wear. The multiple crimped seals, as claimed, provide more secure attachments that resist such drag forces, and prevent or limit problems associated with walking.

The claims depending from claims 8 and 15 are believed to be clearly patentable both for the subject matter they separately recite, as well as by virtue of their dependency from an allowable base claim.

In view of the foregoing remarks, Applicant respectfully requests withdrawal of the rejections under Section 103.

New Claims

New claims 41-47 recast subject matter of various claims already pending, in somewhat different terms. No new matter is added. These claims are believed patentable for the same reasons advanced above with respect to claims 8 and 15.


Conclusion

In view of the remarks and amendments set forth above, Applicants respectfully request allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Attached hereto is a marked-up version of the changes made to the drawings and claims by the current amendment. The attached page is captioned **"Version with markings to show changes made."**

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS

Claim 38 has been amended as follows:

38. (Amended) A bearing assembly made by the method of claim 41 ~~1~~.

The following new claims have been added.

41. (New) A method for installing a seal in a bearing assembly, the method comprising:
positioning a first seal member adjacent to a first annular interface in an inner ring;
positioning a second seal member adjacent to a second annular interface in an outer
ring;
crimping the first seal member to deform a portion of the first seal member into the
first annular interface in the inner ring;
crimping the second seal member to deform a portion of the second seal member
into the second annular interface in the outer ring; and
assembling the bearing assembly such that the first and second seal members
cooperate with one another to seal at least a portion of the bearing assembly.

42. (New) The method of claim 41, further comprising forming the first annular
interface in the inner ring.

43. (New) The method of claim 41, further comprising forming the second
annular interface in the outer ring.

44. (New) The method of claim 41, further comprising:

centering at least one of the first seal member and second seal member in a collet;
and
slidably engaging at least one of the inner ring and the outer ring into the at least one
of the first seal member and the second seal member to close the collet around the
respective one of the first seal member and the second seal member.

45. (New) The method of claim 44, wherein the collet includes a plurality of
flexible fingers each terminating in a crimping head, and disposing the collet to undergo
elastic deformation of the plurality of flexible fingers as the respective portion of the at least
one of the first seal member and second seal member is crimped into the respective at least
one of the first annular interface and the second annular interface.

46. (New) The method of claim 41, wherein at least one of the first seal
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47. (New) The method of claim 41, wherein at least one of the first seal
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first seal member and the second seal member comprising part of an annular support ring.